

REMARKS

Reconsideration of the Office action mailed on June 30, 2004 in connection with the above-identified patent application is requested in view of the foregoing amendments and the following remarks.

Double Patenting

The Examiner made several double patenting rejections, each of which is addressed below. References to cited co-pending claims in the following discussion refer to claims as amended. Additionally, claims 31 and 34 from the present application have been canceled without prejudice so the rejections of those claims are moot.

1. Application Number 10/051,782.

The Examiner provisionally rejected claims 25-27, 29-31 and 34 under the judicially created doctrine of obviousness-type double patenting in light of claims 1 and 20 from co-pending application number 10/051,782. That rejection is traversed.

The cited claims from the present application differ from the cited claims of the co-pending application in that the co-pending claims address later-developed species of the invention claimed in the present application. In other words, the present application includes genus claims while the co-pending application includes later-developed species claims. The present application addresses woodworking machines that include, among other things, a detection system to detect either a dangerous condition or contact between a person and the blade and a reaction system configured to urge the blade away from a work surface upon the detection of the dangerous condition or contact. The cited co-pending claims define later-invented miter saws having a specific pivot arm assembly, a specific housing assembly, and/or a specific brake system or

braking means. The claims in the present application cannot be obvious in light of the cited co-pending claims because the invention recited in the co-pending claims did not exist at the time the invention recited in the present claims was made or at the time the present application was filed. See 35 USC 103 (subject matter must be obvious "at the time the invention was made"). Moreover, applicant could not have filed the claims together in one application, and the inventive entities in the two applications are different. Thus, the present claims should not be rejected based on obviousness-type double patenting.

It may be that the cited claims in the present application encompass or cover the cited co-pending claims. However, that fact by itself is insufficient to support a double patenting rejection. The issues of claim dominance and double patenting must not be confused. MPEP 804 II at 800-20.

Also, if the species claims in the co-pending application are allowed to issue first in order to maintain the double patenting rejection in this case, then a two-way obviousness analysis must be made, as explained in MPEP 804 B.1.(b) and In re Berg, 46 USPQ2d 1226 (Fed. Cir. 1998). A two-way analysis would be required because applicant could not have filed the claims in a single application and because there will have been administrative delay by allowing the co-pending application to issue first in order to maintain the double patenting rejection in this application. If a two-way analysis is made, then there is no obviousness because of differences between the genus and species claims. For all of these reasons, this double patenting rejection should be withdrawn.

2. Application Number 10/052,806.

The Examiner provisionally rejected claim 31 under the judicially created doctrine of obviousness-type double patenting in light of claims 6-15, 19 and 20 from co-pending application number 10/052,806. That rejection is traversed, but is now moot because claim 31 has been canceled without prejudice, as stated previously.

3. Application Number 10/052,273.

The Examiner provisionally rejected claims 25-27 and 29-31 under the judicially created doctrine of obviousness-type double patenting in light of claims 5-24 from co-pending application number 10/052,273. That rejection is traversed.

As with the first double-patenting rejection discussed above, the cited claims from the present application are genus claims while the co-pending application includes later-developed species claims. The cited claims in the present application address woodworking machines with detection systems and reaction systems as described. The cited co-pending claims define later-invented miter saws having specific reaction systems or reaction means. Applicant could not have filed those claims together in one application because the specific reaction systems and reaction means did not exist at the time the invention of the present application was made. Additionally, the inventive entities in the two applications are different. Thus, the claims in the present application cannot be obvious in light of the cited co-pending claims. See 35 USC 103 (subject matter must be obvious "at the time the invention was made").

Again, it may be that the cited claims in the present application encompass or cover the cited co-pending claims, but that fact is insufficient to support a double patenting rejection. The issues of claim dominance and double patenting must not be

confused. MPEP 804 II at 800-20. Also, a two-way obviousness analysis should be applied for this rejection because applicant could not have filed the claims in a single application and because the invention of the present application was made prior to the invention of the co-pending application. MPEP 804 B.1.(b) and In re Berg, 46 USPQ2d 1226 (Fed. Cir. 1998). Under a two-way analysis, there is no obviousness because of differences between the claims.

4. Application Number 10/643,296.

The Examiner provisionally rejected claims 25-27 and 29-31 under the judicially created doctrine of obviousness-type double patenting in light of claims 1-10 from co-pending application number 10/643,296. That rejection is traversed because the cited claims in the present application are genus claims insofar as they all include some reference to urging the axis of a blade away from a work surface or cutting region while the co-pending claims include references to stopping or retracting the blade. Stopping and retracting the blade are subsets or species of urging the blade away, as is evident from the fact that a force may urge a blade away without being sufficiently strong to stop or retract the blade. Additionally, the present application is prior in time to the co-pending application, and the inventive entities in the two applications are different. For all these reasons, this double patenting rejection should be withdrawn.

5. Application Number 09/929,242.

The Examiner provisionally rejected claims 25-27 and 29-31 under the judicially created doctrine of obviousness-type double patenting in light of claims 1-14 from co-pending application number 09/929,242. That rejection is also traversed. As with the other double patenting rejections, the cited claims in the present application are genus

claims to the co-pending claims. The present claims include references to urging a blade away, while the co-pending claims include references to retracting a blade, and retracting a blade is a subset or species of urging a blade away, as stated. Additionally, the present application is prior in time to the co-pending application, and the inventive entities in the two applications are different. Applicant is filing an amendment in application number 09/929,242 canceling without prejudice co-pending claims 2-4, 6, 7, 9 and 11-18, and adding several new claims in order to better focus that application on machines that retract a cutting tool or blade. For all these reasons, this double patenting rejection should be withdrawn.

6. Application Number 09/929,238.

The Examiner provisionally rejected claims 25-27 and 29-31 under the judicially created doctrine of obviousness-type double patenting in light of claims 1-22 and 26-29 from co-pending application number 09/929,238. That rejection is traversed but is now moot because applicant is filing an amendment in application number 09/929,238 canceling without prejudice claims 1-8 and 10-29. The remaining claim 9 from the co-pending application defines a miter saw with a brake mechanism adapted to stop rotation of the blade; it does not claim urging a blade away, so this double patenting rejection should be withdrawn.

Allowable Subject Matter

In the last Office Action the Examiner agreed with applicant's prior comments concerning the allowability of claim 25, and he recognized that the cited references fail to disclose or suggest a machine as described by claim 25. Office Action, 8. The Examiner said:

More specifically, the applied prior art references fail to disclose or suggest a reaction system that includes a brake for decelerating the blade as well as for using a fraction of the angular momentum of the blade to generate a force tending to urge the axis around with [sic] the blade rotates away from the work surface when the brake decelerates the blade. Terauchi teaches using a motor to return the blade instant [sic] of using the angular momentum created by rotation blade [sic]. It is believe[d] that the previous rejection was lacking because it failed to disclose any teaching of angular momentum to urge the blade away from the cutting zone. (Id.)

Accordingly, claim 25 recites allowable subject matter. The only rejections made against claim 25 were the provisional double patenting rejections discussed above, and those rejections should be withdrawn for the reasons given. Therefore, claim 25 should be allowable.

Claim 25 should be allowed even if the Examiner believes questions remain concerning double patenting because those rejections are provisional. The MPEP explains that if provisional double patenting rejections are the only rejections remaining in co-pending applications, then the rejection should be withdrawn in one application to allow the application to issue. MPEP 804 I.B. The provisional rejection can then become an actual rejection in the other application, if appropriate. Applicant asserts that the provisional rejections should be withdrawn in this application rather than in the co-pending applications because this application is the earlier filed application. The MPEP

supports this assertion by saying as an example that the provisional rejection should be withdrawn in the application with the earlier filing date. MPFP 804 I.B. at 800-19.

Claim 26 depends from claim 25 and should also be allowed.

Claim Rejections – 35 USC §103

The Examiner rejected claims 27 and 29-34 under 35 U.S.C. §103(a) as obvious in light of Bosten et al. (U.S. Patent No. 5,285,708) or Meredith (U.S. Patent No. 5,724,875) in view of Lokey (U.S. Patent No. 3,785,230) and Friemann et al. (U.S. Patent No. 3,858,095) or Yoneda (U.S. Patent No. 4,117,752) and Terauchi (U.S. Patent No. 4,512,224). That rejection is traversed because the Terauchi reference is outside the proper scope and content of the art, because there is no teaching or suggestion to combine the references as suggested by the Examiner, and because there is no expectation that the suggested combination would work. However, no further discussion concerning these points is necessary because applicant has amended claim 27 to recite that the reaction system is "adapted to use at least a fraction of the angular momentum of the blade to generate a force tending to urge the axis around which the blade rotates away from the work surface upon the detection of the contact." As stated above in the discussion concerning the allowability of claim 25, the Examiner recognized that the cited references fail to teach or suggest such a reaction system, and therefore, claim 27 now recites subject matter which the Examiner agrees is allowable. Applicant amended claim 27 in order to place that claim in a condition for allowance even though applicant disagrees with the Examiner's conclusions concerning obviousness.

Claims 29 and 30 depend from claim 27 and should be allowable along with claim 27. Claims 29 and 30 also include additional limitations which distinguish the cited references. Claims 31-34 have been canceled without prejudice so the rejection of those claims is moot.

Withdrawn Claims

Applicant requests that withdrawn claims 28 and 35 be reinstated because they depend from claims 27 and 25, respectively, and claims 27 and 25 should now be allowed.

New Claims

Applicant is adding new claims 36-40. These claims distinguish the cited references and should be allowable.

Comments on Statements

In the last Office Action the Examiner commented on a declaration of Stephen Gass which applicant had previously submitted. Applicant does not necessarily agree with or acquiesce in the Examiner's statements concerning that declaration.

The Examiner also made the following comment in the last Office Action:


Applicant contends that the previously applied references lack a detection system adapted to detect contact between a person and the blade; however, it should be noted that this phrase is not limited to any specific physical touching between the user and the blade. The "contact" could be contact of the user within a proximity of the blade. The broadest reasonable interpretation of the phrase, more specifically the term "contact" is the state of immediate proximity. (Office Action, 8-9.)

Applicant disagrees with this statement. The ordinary meaning of the term "contact" plainly refers to a physical touching, it does not refer to immediate proximity.

For the reasons given above, applicant believes the application is in a condition for allowance and applicant requests that it proceed to issuance. Please call the undersigned with any questions.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or facsimile transmitted to the U.S. Patent and Trademark Office to number (703) 872-9306, attention Examiner Boyer D. Ashley, on the date shown below.

Date: October 12, 2004
David A. Fanning